

1 With respect to the amendment of the abstract, the specified
2 language was changed to reflect the language of the
3 specification. No new matter has been added.
4

5 I. THE INVENTION

6 The present invention relates to a method and composition
7 for simultaneously coloring and highlighting hair. The
8 composition contains inorganic persulfates, such as alkali metal
9 or alkaline earth metal persulfates. The composition contains
10 hydrogen peroxide and cationic dye molecules, such as azo,
11 phenazine, thiazine and mixtures thereof.

12 The method involves combining a powdered persulfate, an
13 aqueous developer containing hydrogen peroxide, and an aqueous
14 based colorant compound immediately prior to application.
15 Through this combination of compounds, the one step coloring and
16 highlighting method can be accomplished.
17

18 II. THE EXAMINER'S REJECTIONS

19 In the July 5, 2000 Office Action, the Examiner rejected
20 Claims 5-20 under 35 U.S.C. 112, second paragraph as "being
21 indefinite for failing to particularly point out and distinctly
22 claim the subject matter which applicant regards as the
23 invention". Applicant has the amended claims in accordance with

1 the suggestions of the Examiner.

2 The Examiner also rejected Claims 1-4 under 35 U.S.C. 102(b)
3 as being anticipated by Hoyu. (JP 9-067,235). In the opinion of
4 the Examiner, Hoyu,

5 "exemplifies a composition for bleaching hair which
6 contains 11% by weight inorganic persulfates (including
7 9% by weight sodium persulfate), about 4.8% by weight
8 hydrogen peroxide, and 1% by weight of a quaternary
9 ammonium containing cellulose ether, which reads on the
10 claimed cationic surfactant compounds...Hoyu,
11 therefore, clearly anticipates compositions as
12 claimed."

13 The Examiner also rejected Claims 1-4 under 35 U.S.C. 102(a)
14 as being anticipated by Goldwell. (DE 19721785). The Examiner
15 believes that Goldwell exemplifies a composition which,

16 "contains 0.64% by weight of azo and phenazine cationic
17 dyes, 8.85% by weight inorganic persulfate (including
18 potassium persulfate), 1.28% by weight hydrogen
19 peroxide, and 2.92% by weight of the cationic
20 surfactant/compound hydroxypropyl guar trimmonium
21 chloride. Goldwell therefore anticipates compositions
22 as claimed."
23

24 The Examiner also rejected Claims 1-14 and 16-20 under 35
25 U.S.C. 103(a) as being unpatentable over Goldwell. In the opinion
26 of the Examiner,

27 "The office holds the position that because Goldwell's
28 processes result in the application of the same
29 components as claimed in the claimed amounts at the
30 claimed pH's, Goldwell's processes are not patentably
31 distinct from those as claimed, absent a showing
32 otherwise."

1 Applicant firmly believes that the above amendments and the
2 comments that follow will convince the Examiner that these
3 rejections should be reconsidered and withdrawn. In short,
4 applicant's invention is different from that disclosed in the
5 prior art.

6
7 **III. THE EXAMINER'S REJECTIONS**
8 **SHOULD BE RECONSIDERED**

9 Applicant respectfully submits that the present claims are
10 neither rendered obvious nor anticipated by the cited references.
11 On further reflection, applicant is confident that the Examiner
12 will recognize that any rejections based on Hoyu and Goldwell
13 could only be the result of hindsight reconstruction of the
14 applicant's invention. Moreover, new claims 21-63 are not taught
15 nor rendered obvious by the cited references.

16 As discussed above, the present invention is a one step
17 method to color and highlight hair and a composition therefor.

18 Applicant believes the Examiner's rejection under 35 U.S.C.
19 §112 with respect to claim 15 is no longer applicable as claim 15
20 has been amended in accordance with the Examiner's suggestions.

21 With respect to the rejection of claims 5-20 under 35 U.S.C.
22 §112, applicant submits that the term "aqueous based colorant
23 composition" is not "unclear as to what this composition

comprises." The Examiner asks, "For example, is a colorant required?" The term "aqueous based colorant composition" is adequately described in the specification to contain "one or more cationic dye molecules in aqueous medium." (See Specification, Page 14, lines 6-7.) The term "cationic dye molecule" is further defined as "any hair colorant compound, or dye, that has a positive charge." Clearly, the term is adequately defined within the specification.

With respect to the rejection of claims 1-4 under 35 U.S.C. §102(b), it is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the claim or claims at issue. Reviewing Hoyu, applicant respectfully submits that Hoyu is directed towards a composition for bleaching hair, which does not contain each and every element of amended claim 1. Hoyu does not claim or teach a composition for coloring and highlighting hair.

The Examiner relies on Hoyu, claiming that Hoyu illustrates "a composition for bleaching hair which contains 11% by weight inorganic persulfates, about 4.8% by weight hydrogen peroxide, and 1% by weight of a quaternary ether, which reads on the claimed cationic surfactant compounds." As written, the Examiner claims that Hoyu "clearly anticipates [claim 1] as claimed."

Applicant would like to thank the examiner for bringing an

1 obvious typographical error to her attention. Prior to the
2 amendment contained herewith, claim 1 of the current application
3 purported to claim a composition containing 1-20% inorganic
4 persulfate, 1-20% hydrogen peroxide, 0-10% of at least one
5 cationic dye molecules and 0.01-20% of one or more cationic
6 surfactants. As written, claim 1 was only anticipated by Hoyu if
7 read as an attempt to claim a hair bleaching agent, by claiming
8 protection for a composition containing 0% cationic dye
9 molecules. Such a composition would not be a hair colorant,
10 rather, it would only be a hair bleaching agent such as that
11 disclosed by Hoyu. The current application claims a one step
12 method and composition for simultaneously coloring and
13 highlighting hair. This process necessarily involves the
14 presence of cationic dye molecules disclosed in the specification
15 for coloring the hair.

16 Amended claim 1 contained herewith includes cationic dye
17 molecules as a necessary element in the claim. The claim as
18 amended requires 0.01-10% of at least one or more cationic dye
19 molecules. This range is supported by the specification (page 4,
20 line 19) and is indisputably what applicant disclosed and
21 intended to claim. Such a composition is clearly not anticipated
22 by Hoyu. In fact, simply because Hoyu is a patent involving a
23 hair bleaching agent, and not a hair dying composition, dye

1 molecules are necessarily absent from Hoyu. In fact, no such
2 cationic dye molecules are disclosed in the Hoyu patent. Claim
3 1, as amended, necessarily includes the presence of cationic dye
4 molecules, thereby removing it from the scope of Hoyu, and
5 rendering it unanticipated by Hoyu. Therefore, claim 1, as
6 amended cannot be anticipated by Hoyu, because Hoyu does not
7 disclose each and every element of the claim 1 as amended,
8 specifically the presence of cationic dye molecules.

9 With respect to the Examiner's rejection of claims 1-4 under
10 35 U.S.C. §102(a) with regard to Goldwell, it is black letter law
11 that to be anticipatory, a prior art reference must disclose each
12 and every element of the claim or claims at issue. However,
13 Goldwell does not disclose an improvement disclosed by the
14 current application. Goldwell discloses a combination of a
15 xanthene-based hair dyeing agent, a peroxide based developer and
16 a persulfate based bleaching compound. The current application
17 discloses that a xanthene-based composition is not suitable for
18 use by those who have sensitive or otherwise treated hair.

19 Goldwell discloses a composition which contains xanthan gum
20 (see CALPUS Abstract), thereby falling outside the scope of the
21 current invention. Goldwell is similar in scope to Japanese
22 Patent Publication No. 08175940, (cited in the current
23 application on page 2), wherein both disclose a product

1 containing a xanthene-based dyeing agent, not suitable for use by
2 those with sensitive or chemically treated hair. Therefore,
3 claims 1-4 cannot be anticipated by Goldwell, because Goldwell
4 discloses a composition containing xanthan gum, a disadvantage of
5 the prior art for which this invention was specifically designed
6 to overcome.

7 Further, the Examiner cites In re Hack 245 F.2d 246 (1957)
8 and In re Albertson 332 F.2d 379 (1964) for the proposition that
9 "[t]he intended use of a claimed composition is given little, if
10 any, patentable weight." The Examiner erroneously relies on
11 these two cases for the proposition that the claimed subject
12 matter should be given less patentable weight because of its
13 intended use with respect to a §102 rejection. In re Hack and In
14 re Albertson hold that merely claiming a new use for an old
15 chemical composition does not automatically overcome a §103
16 obviousness rejection. The Examiner's reliance on In re Hack and
17 In re Albertson is misplaced.

18 With respect to the §103 obviousness rejection of claims 1-
19 14 and 16-20, with respect to Goldwell, the Examiner's rejection
20 could only be the result of hindsight reconstruction of the
21 applicant's invention. The Examiner benefits from having the
22 teachings of applicant's specification before him -- Goldwell did
23 not.

1 Specifically, the applicant respectfully points out that,
2 standing on its own, the reference provides no justification for
3 the combination asserted by the Examiner.

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5 Obviousness cannot be established by combining the teachings
6 of the prior art to produce the claimed invention, absent
7 some teaching or suggestion supporting the combination.
8 Under section 103, teachings of references can be combined
9 only if there is some suggestion or incentive to do so." ACS
10 Hospital Systems Inc. v. Montefiore Hospital, 732 F.2d 1572,
11 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in
12 original).

13
14 The cited reference provides no such suggestion or incentive
15 for a one step method to color and highlight hair and a
16 composition therefor as claimed by the applicant. The cited
17 reference does not identify a pH either, as the Examiner admits,
18 the pH is unidentified in Goldwell. Further, the cited reference,
19 "does not appear to teach the addition of film forming polymers
20 to the aqueous developer solution." Finally, The Examiner
21 readily admits that "Goldwell does not exemplify a method as
22 claimed. Particularly, the patentee does not appear to
23 specifically teach water-containing colorant compositions as
24 claimed." Therefore, Goldwell does not teach the aqueous
25 composition necessary for the one step method and composition
26 therefor which is disclosed and claimed in the current
27 application. Therefore, the obviousness rejection could only be
28 the result of a hindsight view with the benefit of the

1 applicant's specification. However,

2 "[t]o draw on hindsight knowledge of the patented invention,
3 when the prior art does not contain or suggest that
4 knowledge, is to use the invention as a template for its own
5 reconstruction--an illogical and inappropriate process by
6 which to determine patentability. The invention must be
7 viewed not after the blueprint has been drawn by the
8 inventor, but as it would have been perceived in the state
9 of the art that existed at the time the invention was made."
10 (citations omitted) Sesonics v. Aerosonic Corp. 38 USPQ 2d.
11 1551, 1554 (1996).
12

13 Under the circumstances, applicant submits that the Examiner
14 has succumbed to the "strong temptation to rely on hindsight."
15 Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012,
16 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983):

17 "It is wrong to use the patent in suit as a guide through
18 the maze of prior art references, combining the right
19 references in the right way so as to achieve the result of
20 the claim in suit. Monday morning quarter backing is quite
21 improper when resolving the question of non-obviousness in a
22 court of law." Id.
23

24 Therefore applicant submits that the only "motivation" for the
25 Examiner's expansion of the cited reference to encompass
26 applicant's invention is provided by the teachings of applicant's
27 own disclosure. No such motivation is provided by the reference
28 itself, or anywhere else in the prior art.

29 The Examiner claims that "it would have been obvious to one
30 of ordinary skill in the art at the time the invention was made
31 to formulate a powdered persulfate-containing-, aqueous
32 developer-, and colorant-composition as claimed...because such

1 compositions and methods fall within the scope of those taught by
2 Goldwell." However, the Examiner readily admits that "Goldwell
3 does not exemplify a method as claimed. Particularly, the
4 patentee does not appear to specifically teach water-containing
5 colorant compositions as claimed." Therefore, Goldwell clearly
6 does not teach the aqueous composition necessary for the one step
7 method and composition therefor which is disclosed and claimed in
8 the current application.

9 With respect to the §103 obviousness rejection of claims 1-
10 14 and 16-20, with respect to Goldwell, in further view of
11 Yoshihara, the combinations advanced by the Examiner would only
12 be proper if supported by the references themselves. However,
13 Goldwell and Yoshihara both fail to support the combination.
14 Quite frankly, these references are unrelated to each other.
15 Moreover, even if the Examiner's reliance on Yoshihara and
16 Goldwell was proper (of course, applicant believes that it is
17 not), the Examiner still needs to rely on applicant's
18 specification to supply additional elements that are completely
19 absent from either reference. This is simply not proper.

20 The Examiner claims that Yoshihara teaches the addition of
21 silicones to hair colorant compositions results in improved hair
22 texture. The Examiner claims it would then have been obvious to
23 one of ordinary skill in the art at the time of invention to add

1 silicone to hair colorant products in view of Goldwell and
2 Yoshihara. The Examiner's emphasis on Goldwell is misplaced as
3 discussed above, and the emphasis on Yoshihara is misplaced as
4 well. Neither discloses a method for applying a single
5 composition to hair for coloring purposes. Further, although the
6 Examiner claims that Yoshihara teaches that silicones are added
7 to hair care compositions to improve hair texture, the elements
8 of the underlying claim are absent from Yoshihara, which claims a
9 dialkylene glycol monoalkyl ether, an aromatic alcohol and a weak
10 acid. Therefore, Yoshihara does not anticipate the current
11 composition as claimed, in light of Goldwell.

12 Standing on their own, these references provide no
13 justification for the combination asserted by the
14 Examiner. "Obviousness cannot be established by
15 combining the teachings of the prior art to produce the
16 claimed invention, absent some teaching or suggestion
17 supporting the combination. Under section 103,
18 teachings of references can be combined only if there
19 is some suggestion or incentive to do so." ACS
20 Hospital Systems Inc. v. Montefiore Hospital, 732 F.2d
21 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed.Cir. 1984)
22 (emphasis in original).
23

24 The Examiner contends that it would be obvious to combine
25 the teachings of Goldwell or Yoshihara with the teachings of the
26 present invention to arrive at applicant's invention. This
27 combination is not legally proper -- on reconsideration the
28 Examiner will undoubtedly recognize that it is actually an

1 "obvious to try" argument. Of course, "obvious to try" is not
2 the standard for obviousness under 35 U.S.C. § 103. Hybritech,
3 Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91
4 (Fed.Cir. 1986).

5 Under the circumstances, we respectfully submit that the
6 Examiner has succumbed to the "strong temptation to rely on
7 hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d
8 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed.Cir. 1983):

9 It is wrong to use the patent in suit as a guide
10 through the maze of prior art references, combining the
11 right references in the right way so as to achieve the
12 result of the claim in suit. Monday morning
13 quarterbacking is quite improper when resolving the
14 question of nonobviousness in a court of law.
15

16 Applicant submits that the only "motivation" for the
17 Examiner's combination of references is provided by the teachings
18 of the applicant's disclosure. No such motivation is provided by
19 the references themselves; nor could there be in view of the
20 difference in subject matter.

21 The Examiner rejected claims 5-8, 11 and 18-20 under 35
22 U.S.C. §103(a) as being unpatentable over Henkel (DE 2,624,690).
23 The Examiner claims that Henkel teaches a three part blonding
24 mixture for hair, and it would have been obvious to one
25 ordinarily skilled in the art at the time the current invention
26 was made to formulate a powdered persulfate composition, an

1 aqueous hydrogen peroxide solution and an aqueous colorant which
2 contains a cationic dye, because such compositions fall inside
3 the scope of the teachings of Henkel. Once again the composition
4 pointed to by the Examiner does not teach the single composition
5 claimed in the current application. The powdered composition
6 claimed in part (i) of amended claim 5 is not taught in the prior
7 art cited to by the Examiner. Nor is the powdered composition
8 suggested by any of the prior art cited by the examiner. The
9 phase distinction is another of the list of differences between
10 the prior art and the current invention. Therefore, the
11 Examiner's reliance on Henkel is misplaced.

12 In conclusion, applicant has disclosed a one step method for
13 simultaneously coloring and highlighting hair, and a composition
14 therefor which represents a significant departure from the cited
15 references. The cited references neither teach nor suggest the
16 novel and nonobvious features of this invention.

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